

### **REMARKS**

Claims 1–21 are pending. By this Reply, claims 1, 2, 4, 6, 11–13, and 16 have been amended, and claims 3, 7–10, and 17–21 have been cancelled. Accordingly, claims 1, 2, 4–6, 11–16, and 22 are currently at issue.

In Paragraph 1 of the Office Action, the Examiner objected to the Specification at page 7, line 15. Applicant has made a correction to the Specification to address the objection.

In Paragraph 3 of the Office Action, the Examiner rejected claims 1-11, 13, 20 and 21 under 35 U.S.C. §112, second paragraph as being indefinite. Applicant has made amendments based on the Examiner's comments and submits that the amendments address the rejections.

#### **Rejections on the Art**

Applicant has cancelled claims 15 and 17–21. This cancellation moots the rejections made in paragraphs 6, 7 and 8 of the Office Action.

In Paragraph 9 of the Office Action, the Examiner rejected claims 1–14 under 35 U.S.C. §103 as being unpatentable over German Patent No. DE 29720696 (“German ’696”) in view of Japanese Patent No. 9-970-014 (“Japan ’014”) and optionally further in view of at least one of the prior art at page 18, lines 12-17 of the specification, Great Britain Patent No. 2174233 (“Great Britain ’233”), and U.S. Patent No. 5,290,067 to Langen (“Langen”). Applicant respectfully traverses this rejection as to the amended claims.

The present invention as claimed is directed to a sticker assembly utilizing a sticker and a vinyl film having a low-tack adhesive layer to form the sticker assembly. The vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing the peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker. With the low-tack adhesive, the sticker assembly can be repositioned on the receiving surface or windshield over and over again. In addition,

the receiving surface or windshield is not damaged including any defroster strips on a car window.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The examiner bears the initial burden on factually supporting any *prima facie* conclusion of obviousness. *See* MPEP §2142; *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

As an initial ground for overcoming the rejection, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness because there is no suggestion or motivation to combine the several different references as suggested by the Examiner. It respectfully appears to Applicant that the Examiner's position is based on hindsight reconstruction gained after review of Applicant's disclosure. *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from the prior art absent some suggestion or motivation in the prior art itself to do so).

Virtually all inventions are combinations of old elements. Therefore, an Examiner may often find every element of a claimed invention in prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *Yamanouchi Pharmaceutical*

*Co. v. Danbury Pharmacal Inc.*, 231 F.3d 1339, 56 USPQ2d 1641, 1644 (Fed. Cir. 2000).

The Examiner makes numerous conclusions on pages 5–10 regarding what one of ordinary skill in the art would appreciate. These conclusions, however, are not supported by specific disclosures in the references themselves, that would give the one of ordinary skill in the art the motivation to combine the several different references as suggested by the Examiner. The Examiner has merely cited to several different patents in an effort to piece together elements of the prior art to read on Applicant’s claimed invention. As discussed above, the suggestion to combine requirement prevents such hindsight reconstruction. Without the requisite motivation, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1, 2, 4–6 and 11–14.

As another ground for overcoming the rejection, the combination of the several different references does not disclose or suggest all of the elements of the claims as amended.

Claim 1 requires, among other things, that “the vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker.” This element is not disclosed or suggested in any of the several different references cited by the Examiner in Paragraph 9 of the Office Action. German ’696 is void of any discussion of trimming. Japan ’014 is likewise void of any discussion of trimming. The prior art discussed in the specification merely refer to traditional window stickers with permanent adhesive. Great Britain ’233 and Langen also do not disclose or suggest trimming a vinyl film as claimed.

The trimming element of the present invention provides several advantages. By trimming the vinyl film so the peripheral edges are essentially in registry, the vinyl film is virtually undetectable. Thus, only the owner of the sticker assembly knows of its presence. This helps to avoid theft of the

sticker assembly. It also avoids unsightliness such as when the peripheral edges of the film extend beyond the sticker. This would surely happen in German '696 as there is absolutely no disclosure or suggestion for trimming. Over the course of time, Applicant has taken several questions from retail and commercial users regarding the peripheral edges of the vinyl film extending beyond the peripheral edges of the sticker. Applicant has had to indicate to the users to trim the edges as disclosed and claimed in the present application. Thus, the trimming element can hardly be considered as obvious. In addition, by trimming the vinyl film, more sticker assemblies can be placed on a windshield without overlapping. Also, the edges of the sticker acts as a guide for the trimming as shown in FIG. 6.

The cited art is simply void of the trimming element as claimed. Thus, the proposed combination cannot establish a *prima facie* case of obviousness with respect to claim 1. Applicant submits that claim 1 is patentably distinct over the cited references.

Claim 2 requires, among other things, "trimming the vinyl film thereby placing peripheral edges of the vinyl film in registry with peripheral edges of the windshield sticker." For the reasons stated with respect to claim 1, Applicant submits that claim 2 is patentably distinct over the cited references.

Claims 4 and 5 depend from claim 2 and include all of the elements of claim 2. Applicant submits that claims 4 and 5 are patentably distinct for the same reasons with respect to claim 2.

Claim 6 requires, among other things, that "the vinyl film is trimmed such that peripheral edges of the vinyl film are essentially in registry with peripheral edges of the window sticker" and that "the indicia-bearing sticker is viewable through the window from outside of the vehicle and the vinyl film is undetectable when viewed through the window from outside of the vehicle." For the reasons stated with respect to claim 1, claim 6 is also patentably distinct over the cited references.

Applicant notes the Examiner's conclusion that German '696 is considered to suggest a sticker and window sticker removal aid having the same size. Applicant respectfully disagrees. There is simply no disclosure or suggestion in German '696 that the sticker and removal aid have the same size.

Furthermore, none of the cited art disclose or suggest the trimming element such that the vinyl film is undetectable when viewed through the window from outside the vehicle. The trimming element helps in making the vinyl film virtually undetectable when mounted on the window so that only its owner would know the sticker is releasably adhered. Applicant submits that claim 6 is patentably distinct over the cited references.

Claim 11 requires, among other things, the step of "trimming the vinyl film thereby placing the peripheral edges of the vinyl film in registry with peripheral edges of the windshield sticker." For the reasons stated with respect to claim 1, Applicant submits that claim 11 is patentably distinct over the cited art.

Claim 12 requires, among other things, that "the vinyl film is trimmed such that peripheral edges of the vinyl film are essentially in registry with peripheral edges of the window sticker" and "wherein the vinyl film is undetectable when viewable through the windshield from outside the vehicle." For the reasons stated with respect to claims 1 and 6, Applicant submits that claim 11 is patentably distinct over the cited art.

In addition, claim 12 requires a "hard vinyl film" wherein the first side of the film has "a top coat." The top coat improves the bond between the sticker and the vinyl film and is disclosed at page 26, lines 10–11 of the specification as filed. None of the cited art discloses or suggests the use of a hard vinyl film as claimed. A hard vinyl is a stiffer material that assists in preventing the sticker assembly from peeling away or curling from the receiving surface or windshield. Also, none of the cited art discloses or suggests the use of a top coat with the vinyl film as claimed. The top coat

assists in preventing the vinyl film from separating from the sticker due to different conditions such as temperature or sunlight. For these additional reasons, Applicant submits that claim 12 is patentably distinct over the cited art.

Claim 13 requires, among other things, “trimming the first strip of vinyl film to correspond in size to the first strip of adhesive on the sticker” and “trimming the second strip of vinyl film to correspond in size to the second strip of adhesive on the sticker.” For the reasons stated with respect to claim 1, Applicant submits that claim 13 is patentably distinct over the cited art.

On page 10 of the office action, the Examiner concluded that the limitation of trimming the strips would have been obvious in view of Langen’s teaching to cut the strips so as to have the same length as the sticker and referring to FIGS. 1 and 2 of Langen. Langen, however, does not teach cutting strips of vinyl film. Langen discloses the use of a repositionable adhesive and release strip and the use of double-sided tape 34 having a release liner 37. (*See e.g.*, col. 3, lns. 58–59; col. 4, lns. 47–57). As there is no disclosure or suggestion of trimming, the adhesive and release liner must initially be made the same size in Langen. Furthermore, neither the tape 34 or the release liner 37 is a vinyl film that is trimmed and to correspond in size to a separate strip of adhesive. The tape 34 is an integral assembly with adhesive on both its sides. Thus, if a double-sided tape is used, the release liner is automatically sized wherein there is no need for another trimming operation. There is plainly no disclosure or suggestion of a step of trimming a strip of vinyl film to correspond in size to the first strip of adhesive on the sticker. In fact, Langen teaches away from such a configuration as it discloses that the application of adhesive and protective strips is done simultaneously (*See Abstract*). Thus, the proposed combination of any of the references with Langen does not render as obvious, the trimming step as claimed and, therefore, cannot establish a *prima facie* case of obviousness with respect to claim 13.

Furthermore, based on the Examiner's rejection in paragraph 10 of the Office Action, it would be improper to conclude that Gladden, in combination with the other cited references, establishes a *prima facie* case of obviousness. There is simply not a specific disclosure in any of the references that would have given one the motivation to make such a combination. Any attempt to do so is a plain example of impermissible hindsight reconstruction using Applicant's claims as the blueprint for such combination.

Claim 14 requires, among other things, that "the strips are trimmed to correspond in size to the strips of adhesive." Claim 14 also requires that "the strips are undetectable when viewable through the windshield from outside of the vehicle." For the reasons stated with respect to claims 1 and 13, Applicant submits that claim 14 is patentably distinct over the cited art.

In Paragraph 10 of the Office Action, the Examiner rejected claims 3 and 7 under 35 U.S.C. §103 as being unpatentable over German Patent No. DE 29720696 ("German '696") in view of Japanese Patent No. 9-970-014 ("Japan '014") and optionally further in view of at least one of the prior art at page 18, lines 12–17 of the specification, Great Britain Patent No. 2174233 ("Great Britain '233"), U.S. Patent No. 5,290,067 to Langen ("Langen"), and further in view of U.S. Statutory Invention Registration H46 to Gladden ("Gladden"). Applicant has canceled claims 3 and 7 thereby mooting this rejection.

In Paragraph 11 of the Office Action, the Examiner rejected claim 9 under 35 U.S.C. §103 as being unpatentable over German Patent No. DE 29720696 ("German '696") in view of Japanese Patent No. 9-970-014 ("Japan '014") and optionally further in view of at least one of the prior art at page 18, lines 12–17 of the specification, Great Britain Patent No. 2174233 ("Great Britain '233"), U.S. Patent No. 5,290,067 to Langen ("Langen") as applied above and further in view of U.S. Patent No. 4,225,369 to Felchin ("Felchin"). Applicant has canceled claim 9 thereby mooting this rejection.

In Paragraph 12 of the Office Action, the Examiner rejected claims 1–4, 6–7, and 9–14 under 35 U.S.C. § 103 as being unpatentable over Langen in view of U.S. Patent No. 4,935,288 to Honaker (“Honaker”). Applicant respectfully traverses this rejection in view of the amended claims.

As discussed above, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The examiner bears the initial burden on factually supporting any *prima facie* conclusion of obviousness. *See* MPEP ' 2142; *In re Vaeck*, 20 USPQ.2d 1438 (Fed. Cir. 1991).

As an initial ground for overcoming the rejection, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness because there is no suggestion or motivation to combine Langen and Honaker as suggested by the Examiner. Langen is directed to a repositionable window pricing label while Honaker is directed to a coated laser printed label. Even though both patents are directed to labels, the Examiner has still failed to cite to a specific disclosure in either reference that would have given one the motivation to combine them as proposed by the Examiner. Consequently, the proposed combination cannot establish a *prima facie* case of obviousness with respect to the claims.

As another ground for overcoming the rejection, the combination of Langen and Honaker does not disclose or suggest all of the elements of the claims as amended.

Claim 1 requires, among other things, that “the vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker.” This element is not disclosed or suggested in Langen or Honaker. Honaker is completely void of any such disclosure. In addition, Langen does not teach cutting a vinyl



film to have peripheral edges in registry with the sticker. Langen discloses the use of a repositionable adhesive and release strip and the use of double-sided tape 34 having a release liner 37. (*See e.g.*, col. 3, lns. 58–59; col. 4, lns. 47–57). As there is no disclosure or suggestion of trimming, the adhesive and release liner must initially be made the same size in Langen. Furthermore, in the double-sided tape embodiment, neither the tape 34 or the release liner 37 is a vinyl film that is trimmed to be in registry with the sticker. The tape 34 is an integral assembly with adhesive on both its sides. Thus, if a double-sided tape is used, the release liner is automatically sized wherein there is no need for another trimming operation. There is plainly no disclosure or suggestion of a step of trimming a vinyl film to correspond in size to a sticker. In fact, Langen teaches away from such a configuration as it discloses that the application of adhesive and protective strips is done simultaneously (*See Abstract*).

As discussed, the trimming element of the present invention provides several advantages. By trimming the vinyl film so the peripheral edges are essentially in registry, the vinyl film is virtually undetectable. Thus, only the owner of the sticker assembly knows of its presence. This helps to avoid theft of the sticker assembly. It also avoids unsightliness such as when the peripheral edges of the film extend beyond the sticker. In addition, by trimming the vinyl film, more sticker assemblies can be placed on a windshield without overlapping. Also, the edges of the sticker acts as a guide for the trimming as shown in FIG. 6.

The cited art is simply void of the trimming element as claimed. Thus, the proposed combination of Langen and Honaker does not render the trimming step as claimed obvious. Accordingly, the proposed combination cannot establish a *prima facie* case of obviousness with respect to claim 1. Applicant submits that claim 1 is patentably distinct over the cited references.

Claim 2 requires, among other things, “trimming the vinyl film thereby placing peripheral edges of the vinyl film in registry with peripheral edges of the windshield sticker.” For the reasons

stated with respect to claim 1, Applicant submits that claim 2 is patentably distinct over the cited references.

Claim 4 depends from claim 2 and includes all of the elements of claim 2. Applicant submits that claim 4 is patentably distinct for the same reasons with respect to claim 2.

Claim 6 requires, among other things, that “the vinyl film is trimmed such that peripheral edges of the vinyl film are essentially in registry with peripheral edges of the window sticker” and that “the indicia-bearing sticker is viewable through the window from outside of the vehicle and the vinyl film is undetectable when viewed through the window from outside of the vehicle.” For the reasons stated with respect to claim 1, claim 6 is also patentably distinct over the cited references.

Furthermore, none of the cited art disclose or suggest the trimming element such that the vinyl film is undetectable when viewed through the window from outside the vehicle. The trimming element helps in making the vinyl film virtually undetectable when mounted on the window so that only its owner would know the sticker is releasably adhered. Applicant submits that claim 6 is patentably distinct over the cited references.

Claim 11 requires, among other things, the step of “trimming the vinyl film thereby placing the peripheral edges of the vinyl film in registry with peripheral edges of the windshield sticker.” For the reasons stated with respect to claim 1, Applicant submits that claim 11 is patentably distinct over the cited art.

Claim 12 requires, among other things, that “the vinyl film is trimmed such that peripheral edges of the vinyl film are essentially in registry with peripheral edges of the window sticker” and “wherein the vinyl film is undetectable when viewable through the windshield from outside the vehicle.” For the reasons stated with respect to claims 1 and 6, Applicant submits that claim 12 is patentably distinct over the cited art.

In addition, claim 12 requires a “hard vinyl film” wherein the first side of the film has “a top coat.” The top coat improves the bond between the sticker and the vinyl film and is disclosed at page 26, lines 10–11 of the specification as filed. None of the cited art discloses or suggests the use of a hard vinyl film as claimed. A hard vinyl is a stiffer material that assists in preventing the sticker assembly from peeling away or curling from the receiving surface or windshield. Also, none of the cited art discloses or suggests the use of a top coat with the vinyl film as claimed. The top coat assists in preventing the vinyl film from separating from the sticker due to different conditions such as temperature or sunlight. For these additional reasons, Applicant submits that claim 12 is patentably distinct over the cited art.

None of the cited art disclose or suggest the use of a hard vinyl film as claimed nor the use of a top coat with the vinyl film as claimed. For these additional reasons, Applicant submits that claim 12 is patentably distinct over the cited art.

Claim 13 requires, among other things, “trimming the first strip of vinyl film to correspond in size to the first strip of adhesive on the sticker” and “trimming the second strip of vinyl film to correspond in size to the second strip of adhesive on the sticker.” For the reasons stated with respect to claim 1, Applicant submits that claim 13 is patentably distinct over the cited art.

On pages 12 and 13 of the office action, the Examiner concluded that the limitation of trimming the strips would have been obvious in view of Langen’s teaching to cut the strips so as to have the same length as the sticker and referring to FIGS. 1 and 2 of Langen. As discussed however, Langen does not teach cutting strips of vinyl film. Langen discloses the use of a repositionable adhesive and release strip and the use of double-sided tape 34 having a release liner 37. (*See e.g.*, col. 3, lns. 58–59; col. 4, lns. 47–57.) Neither the tape 34 or the release liner 37 is a vinyl film that is trimmed and to correspond in size to a separate strip of adhesive. The tape 34 is an integral assembly with

adhesive on both its sides. Thus, if a double-sided tape is used, the release liner is automatically sized wherein there is no need for another trimming operation. There is no disclosure or suggestion of a step of trimming a strip of vinyl film to correspond in size to the first strip of adhesive on the sticker. In fact, Langen teaches away from such a configuration as it discloses that the application of adhesive and protective strips is done simultaneously (*See Abstract*). Thus, the proposed combination of the cited references does not render the trimming step as claimed obvious and, therefore, cannot establish a *prima facie* case of obviousness with respect to claim 13.

Claim 14 requires, among other things, that “the strips are trimmed to correspond in size to the strips of adhesive.” Claim 14 also requires that “the strips are undetectable when viewable through the windshield from outside of the vehicle.” For the reasons stated with respect to claims 1 and 13, Applicant submits that claim 14 is patentably distinct over the cited art.

In Paragraph 14 of the Office Action, the Examiner rejected claims 15–20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1–6 of U.S. Patent No. 6,258,200. Applicant submits herewith a terminal disclaimer.

In Paragraph 15 of the Office Action, the Examiner indicated that claim 18 would be allowable if rewritten in independent form and the double patenting rejection is overcome. Applicant has amended claim 16 to incorporate the elements of claim 18. Applicant has also submitted a proper terminal disclaimer.

Applicant has added claim 22. Applicant submits that claim 22 is patentably distinct over the cited references.

### CONCLUSION

In view of the above, it is submitted the application is in condition for allowance. Such action is respectfully requested. Further, the Examiner is requested to contact the undersigned if the Examiner has any questions concerning this Reply or if it will expedite the progress of this application.

Respectfully submitted,

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By: Paul J. Nykaza

Paul J. Nykaza, Registration No. 38,984  
Wallenstein Wagner & Rockey, Ltd.  
311 South Wacker Drive, 53rd Floor  
Chicago, Illinois 60606-6630  
(312) 554-3300  
Attorneys for Applicant

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Robert Holland  
Robert Holland

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